



UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re application of

Franz Kraemling

Serial No. 09/223,472

Filed: December 30, 1998

For: ELECTROPLATING CELL BASED UPON ROTATIONAL PLATING SOLUTION FLOW

:
:
: DECISION ON
: PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO REOPEN PROSECUTION AFTER APPEAL DUE TO A NEW GROUND OF REJECTION IN EXAMINER'S ANSWER filed on May 30, 2003.

On January 6, 2003, an appeal brief was filed by applicants. On March 26, 2003, an Examiner's Answer was mailed in response to said brief.

On May 30, 2003 the instant petition under 37 CFR 1.181 was timely filed to formally request reopening of prosecution due to a new ground of rejection raised in the Examiner's Answer.

DECISION

Petitioner argues that the Examiner's Answer contains an impermissible new ground of rejection. On page 8 of the answer, the Examiner states "If the nozzles are parallel to the plate electrodes, then they are clearly at an angle, in this case a right angle, other than normal to the surface of the plate electrodes." Petitioner argues that the Answer provides the first interpretation by the examiner of "an angle." It is Petitioner's position that the interpretation of the word "angle," newly provided in the Answer is a new ground of rejection. Petitioner states that "Appellant has not previously been aware that the Examiner has taken "angle" to include "parallel" or "an angle of 0°."

Section 1208.01 of the MPEP states:

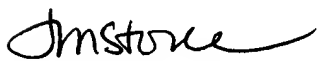
37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976).

Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

In the instant application, the statutory basis for the rejection remains the same as that which was set forth in the final rejection. In response to Petitioner's argument that the Examiner raised the issue of "an angle" including parallel and "an angle of 0°" for the first time in the Examiner's Answer thereby not giving Appellants a chance to respond to this position, attention is directed to the Office Action mailed October 23, 2001. On page 4, lines 3-5, the Examiner states "It is noted that the expression "an angle" includes angles extending from essentially zero degrees to 180 degrees." Next, turning to Applicant's response filed February 14, 2002, on page 8, last paragraph, Applicants state "The Examiner argues that the claim "an angle" includes angles extending from essentially 0° to 180°." From the record, it is clear that the Examiner's position set forth in the Examiner's Answer regarding the definition of "an angle" was not only presented by the Examiner in a previous Office Action, but also acknowledged by Applicants in a response. Therefore, the basic thrust of the rejection remains the same in the Examiner's Answer such that Appellants have been given a fair opportunity to react to the rejection.

Accordingly, the petition is **DENIED**. The Application remains under Appeal and will be forwarded to the Board of Appeals for consideration thereof.



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